



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,712	12/13/1999	NORIKO YURINO	07898/053001	1549

7590 03/24/2003

Stanley P. Fisher
REED SMITH LLP
3110 Fairview Park Drive
suite 1400
Falls Church, VA 22042

EXAMINER

MARSCHER, ARDIN H

ART UNIT PAPER NUMBER

1631

DATE MAILED: 03/24/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/459,712

Applicant(s)

Yurino et al.

Examiner

Ardin Marschel

Art Unit

1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 20, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 and 22-24 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 20
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) see attached 6) ☐ Other:

Applicants' arguments, filed 11/20/02, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 10-20 and 22-24 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 16 and 24 step (a) cites the providing of a plurality of probes which are each separately immobilized on a different and predetermined position thereon. Step (c) then cites the contacting of the sample with the probe. Since a plurality of probes was cited in step (a), the step (c) contacting lacks clear antecedent basis as to what probe of this plurality is meant. Two additionally unclear interpretations are present due to this claim wording. One interpretation is that the sample is limited as to its contacting in step (c) to a particular probe without contacting other probes in said plurality. Another interpretation is that the sample is contacted with the substrate on which the plurality of probes are immobilized such that all of the plurality in step (a) are contacting with the sample, however, this is not clearly stated

as such in the claims. The instant Figures appear to be directed only to the second interpretation without depicting the first interpretation in any of the Figures. No separate single probe/sample contacting has been found in the instant specification. Thus, the claims are not commensurate in scope with either of the Figures or instant specification. Clarification of what is meant by the claim practice via clearer claim wording is requested. Claims dependent directly or indirectly from claims 16 or 24 are included as rejected hereinunder due to said dependence.

An added unclarity is the lack of clear antecedent basis as to what probe is meant by "amount of the probe" in the last lines of claims 16 and 24. It is noted that steps (a) of claims 16 and 24 are directed to providing a plurality of probes. Clarification of what is meant by the claim practice via clearer claim wording is requested. Claims dependent directly or indirectly from claims 16 or 24 are included as rejected hereinunder due to said dependence.

It is noted that claim 16 includes step (e) directed to the detecting of "hybridized" biopolymer which is indicative of the hybridization reaction that occurs between nucleobases. The antecedent basis is thus unclear for claim 22 which conflictly is directed to protein practice. Clarification via clearer claim wording is requested.

Claims 10-15, 17-20, 22, and 23 all depend directly or indirectly from claim 16 which contains the vagueness and indefiniteness of the confusing phrase therein given as "each different and separate predetermined and the" which seems to be lacking the word "position" after "predetermined". This lacking of the word "position" is different from the similar phrase in the last three lines of claim 16 which does contain said word "position". Clarification via clearer claim wording is requested.

IDS

The enclosed PTO Form 1449 contains a lined through document from Japan which cannot be considered since none of its content is in English. The European Search report is lined through due to its lacking a date of publication as such reports are not published. The date on said report apparently is not a date of publication.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M.

Serial No. 09/459,712

- 5 -


Art Unit: 1631

to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703)308-0196.

March 21, 2003


ARDIN H. MARSCHEL
PRIMARY EXAMINER